



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/002,349	01/02/1998		040808-5058	7725

9629 7590 12/29/2004
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

TILLERY, RASHAWN N

ART UNIT PAPER NUMBER

2612

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/002,349

Applicant(s)

IKEDA,, OSAMU

Examiner

Rashawn N Tillery

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13, 21 and 22 is/are allowed.
- 6) ☒ Claim(s) 14-20 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed July 6, 2004 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding Applicant's arguments concerning the combination of McIntyre and Ishibashi failing to disclose the claimed function tester, the examiner respectfully disagrees. The examiner notes that Applicant's claim language is written in the alternative- functions of any one or more of the operation input unit, the image pickup unit, the recorder and the playback unit are tested. As stated in the previous office action, Ishibashi teaches testing all functions of the camera.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 14-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McIntyre et al (US5894326) in view of Ishibashi et al (US4316656).

Regarding claims 14 and 23, McIntyre discloses, in figure 1, an electronic camera (1), comprising:

- an operation input unit (32d; see col. 2, line 62 to col. 3, line 36) for inputting external operations that designate corresponding functions of the camera;

- an image pickup unit (20) for capturing an image of an object;

- a recorder (35) for recording the image captured by the image pickup unit on a recording medium;

- a playback unit (see col. 4, lines 49-64; McIntyre is capable of retrieving and displaying images stored in a temporary memory when the user determines that the image is to be printed) having a display for at least playing back image information that is recorded on the recording medium; and

- a mode selector (McIntyre is capable of setting an image capture mode and a image print mode) for selecting an operation mode.

McIntyre does not expressly disclose a diagnosis mode which includes a function tester for testing functions of the camera. However, Ishibashi discloses useful function and status information of camera operation under the control of various function test select buttons disposed about the camera housing (see col. 1, lines 28-53). Ishibashi discloses an exposure or iris setting indicator which includes iris or aperture representation (see col. 2, lines 50-52). This iris setting indicator inherently performs some form of test to provide the indication of the iris setting. It would have been

Art Unit: 2612

obvious to modify the McIntyre camera to include a diagnosis mode which includes a function tester as taught by Ishibashi to provide status information of functions of a camera to ensure proper camera operation.

Regarding claim 15, see claim 14 above.

Regarding claim 16, the combination of McIntyre and Ishibashi disclose the playback unit plays back image information that is recorded on the recording medium in accordance with an external operation specifying a playback function of the playback unit (McIntyre is capable of retrieving and displaying images stored in a temporary memory when the user determines that the image is to be printed; this can either be done by user control unit 32d or by shifting the display unit to its "print position"), and wherein while the camera is set to the function diagnosis mode by the mode selector, the function tester tests the playback function of the playback unit specified by the external operation (see claim 14 above). Neither McIntyre nor Ishibashi explicitly disclose a sound reproducing device. However, Official Notice is taken that it is well known in the camera to record and reproduce audio data along side image data. It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement such teachings since the recording and reproduction of audio data is notoriously associated with image data.

Regarding claim 17, the combination of McIntyre and Ishibashi disclose displaying test results generated by the function tester since Ishibashi discloses useful function and status information of camera operation under control of various function test select buttons disposed about the camera housing wherein an all-test button is

Art Unit: 2612

provided to actuate various function indicators by the quantity indicator in a test function sequence for a readout of all the displayed camera functions (see col. 1, lines 28-53 of Ishibashi).

Regarding claim 18, McIntyre discloses, in figure 1, an electronic camera having a plurality of functions including capturing and recording images, comprising:

a mode selector (McIntyre is capable of setting an image capture mode and a image print mode) externally switchable to select a variety of modes including a normal mode.

an operation input unit (32d; see col. 2, line 62 to col. 3, line 36) for inputting external operations that initiate corresponding functions of the camera while the camera is in a normal mode;

an image pickup unit (20) for capturing an image of an object;

a recorder (35) for recording the image captured by the image pickup unit on a recording medium;

a playback unit (see col. 4, lines 49-64; McIntyre is capable of retrieving and displaying images stored in a temporary memory when the user determines that the image is to be printed) having a display for at least playing back image information that is recorded on the recording medium in accordance with the external operations inputted through the operation input unit while the camera is in a normal mode; and

McIntyre does not expressly disclose a diagnosis mode which includes a function tester for testing functions of the camera. However, Ishibashi discloses useful function and status information of camera operation under the control of various function test

Art Unit: 2612

select buttons disposed about the camera housing (see col. 1, lines 28-53). Ishibashi discloses an exposure or iris setting indicator which includes iris or aperture representation (see col. 2, lines 50-52). This iris setting indicator inherently performs some form of test to provide the indication of the iris setting. It would have been obvious to modify the McIntyre camera to include a diagnosis mode which includes a function tester as taught by Ishibashi to provide status information of functions of a camera to ensure proper camera operation.

Regarding claim 19, McIntyre does not explicitly state that the camera includes a diagnosis mode which includes a function tester for automatically testing function. However, Ishibashi discloses automatically displaying predetermined camera functions during testing function (col. 2, lines 3-9). It would have been obvious to one of ordinary skill in the art to modify the McIntyre camera to include a diagnosis mode which includes a function tester as taught by Ishibashi to provide status information of functions of a camera to ensure proper camera operation.

Regarding claim 20, see claim 18 above.

Allowable Subject Matter

Claims 1-13, 21 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 1, 21 and 22, the prior art does not teach or fairly suggest an electronic camera having a plurality of functions including capturing and recording

Art Unit: 2612

images comprising an operation input unit, an image pickup unit, a recorder, a playback unit and a mode selector for selecting one operation mode of the camera from a plurality of available operation modes that include an operation explanation mode, wherein

if the operation explanation mode is selected, the playback unit plays back an operation guide that is pre-stored in a memory, the operation guide explaining at least one of the external operations and corresponding camera functions thereof, wherein at least the mode selector, the operation input unit, the recorder and the display are enclosed within a main camera body.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

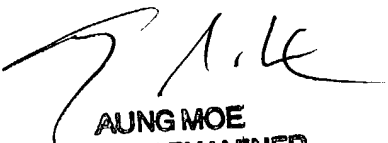
Art Unit: 2612

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rashawn N Tillery whose telephone number is 703-305-0627. The examiner can normally be reached on 9AM-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on 703-305-4929. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RNT


AUNG MOE
PRIMARY EXAMINER